

**UNITED STATES DISTRICT COURT  
DISTRICT OF MINNESOTA**

ROTARY SYSTEMS, INC.,  
a Minnesota corporation,

Plaintiff,

v.

HENDRICKSON USA, LLC,  
an Illinois corporation,

Defendant.

Civil File No. 09cv1563

(Trial by Jury Demanded)

Pat. # 7,273,082

PJS / JSM

**COMPLAINT**

Plaintiff Rotary Systems, Inc. ("RSI"), for its Complaint against Defendant Hendrickson USA, LLC ("Hendrickson"), respectfully hereby states and alleges as follows:

**PARTIES**

1. Plaintiff RSI is a Minnesota corporation with its principal place of business at 14440 Azurite Street NW, Ramsey, MN 55303.
2. Upon information and belief, Defendant Hendrickson is an Illinois corporation with its principal place of business at 500 Park Boulevard, Suite 1010, Itasca, IL 60143.

**JURISDICTION AND VENUE**

3. Subject matter jurisdiction is based on 28 U.S.C. §§ 1331, 1338(a), 2201 and 2202, in that this action arises under the patent laws of the United States (35 U.S.C. § 1 et seq.) and there is a case of actual controversy between Plaintiff RSI and Defendant Hendrickson.
4. On information and belief, Defendant Hendrickson conducts business in this District, has conducted business with Plaintiff RSI in this District, and is subject to personal jurisdiction pursuant to Minn. Stat. § 543.19.

**SCANNED**

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5. Venue is proper in this Court under 28 U.S.C. §§ 1391.

### **GENERAL ALLEGATIONS**

6. Plaintiff RSI is a Minnesota company that specializes in the design and fabrication of rotary unions.

7. In February 2000, Plaintiff RSI entered into a verbal agreement with Defendant Hendrickson to develop a rotary union for use by Defendant Hendrickson as part of a tire inflation system it was developing, which allows a tire to be inflated while rotating as the vehicle is being driven.

8. Over the next couple of years, Plaintiff RSI designed various alternative rotary unions in an attempt to meet the needs of Defendant Hendrickson's tire inflation system. These designs were submitted to Defendant Hendrickson for its evaluation and testing.

9. In 2002, Plaintiff RSI's Design Engineer, Gerald Szykulski, conceived and designed a two-piece rotary union, drawings of which were provided by Plaintiff RSI to Defendant Hendrickson.

10. On November 13, 2003, unbeknownst to Plaintiff RSI, Defendant Hendrickson filed a provisional patent application (Serial No. 60/520,202), entitled "Tire Inflation System" (hereinafter "the '202 Provisional Application"). A copy of the '202 Provisional Application is attached hereto as Exhibit A.

11. The '202 Provisional Application included a written description and drawing figures for a two-piece rotary union for a tire inflation system. The written description states "the rotary union of the system includes several aspects that make it more dependable and likely longer-lived than rotary unions of the prior art." The written description also includes a "Fourth

Aspect – Rotary Union” section describing a two-piece rotary union that overcomes the disadvantages of the rotary unions in the prior art.

12. On March 5, 2004, unbeknownst to Plaintiff RSI, Defendant Hendrickson filed a non-provisional patent application (Serial No. 10/794,942) (hereinafter “the ‘942 Application”), entitled “Tire Inflation System Apparatus and Method” claiming priority to the ‘202 Provisional Application. The ‘942 Application published on September 9, 2004 as U.S. Patent Publication No. 2004/0173296 A1, which is attached hereto as Exhibit B.

13. On April 19, 2004, unbeknownst to Plaintiff RSI, Defendant Hendrickson filed a second non-provisional application (Serial No. 10/827,040), entitled “Tire Inflation System Apparatus and Method,” which claims priority as a continuation-in-part to the ‘942 Application. The ‘040 Application published as U.S. Patent Publication No. 2005/0194080 A1 on September 8, 2005. The ‘040 Application issued as U.S. Patent No. 7,273,082 (hereinafter “the ‘082 Patent”) on September 25, 2007, which is attached hereto as Exhibit C.

14. Neither the ‘202 Provisional Application, the ‘942 Application, the ‘040 Application, nor the ‘082 Patent list Plaintiff RSI’s Design Engineer, Gerald Szykulski, as an inventor.

15. Upon information and belief, the ‘082 Patent and the related patent applications – the ‘202 Provisional Application, the ‘942 Application and the ‘040 Application, are all assigned to Defendant Hendrickson.

16. The ‘942 Application, the ‘040 Application and the ‘082 Patent include a written description and drawing figures for a two-piece rotary union for a tire inflation system. The written descriptions state “the rotary union of the system includes several aspects that make it more dependable and likely longer-lived than rotary unions of the prior art.” The written

description also includes the statement that “[r]otary union 34 of present invention tire inflation system 10 overcomes these disadvantages [of the prior art].”

17. Upon information and belief, either the same drawing figures of the two-piece rotary union provided by Plaintiff RSI to Defendant Hendrickson, or slight modifications thereto, were provided in the ‘202 Provisional Application, the ‘942 Application and the ‘040 Application. Upon information and belief, formalized drawings of the same drawing figures of the rotary union provided by Plaintiff RSI to Defendant Hendrickson, or slight modifications thereto, are in the ‘082 Patent.

18. After supplying final drawings of the two-piece rotary union to Defendant Hendrickson, Plaintiff RSI supplied Defendant Hendrickson with the two-piece rotary unions invented by its Design Engineer, Gerald Szykulski, until July 2005 when Defendant Hendrickson informed Plaintiff RSI that it was turning to a third party supplier.

19. Only after Defendant Hendrickson dropped Plaintiff RSI as its supplier did Plaintiff RSI become aware in or about July 2005 that Defendant Hendrickson had filed the ‘202 Provisional Application and the ‘942 Application without listing its Design Engineer, Gerald Szykulski, as an inventor.

20. On August 1, 2005, in order to preserve the rights to his invention, Gerald Szykulski filed a request to correct inventorship of the ‘942 Application. Gerald Szykulski also filed a divisional patent application (hereinafter “the Szykulski Application”) claiming priority to the ‘942 Application and the ‘202 Provisional Application.

21. The Szykulski Application lists Gerald Szykulski as the sole inventor as the claims filed in the Szykulski Application were directed only to the rotary union structure invented by Plaintiff RSI’s Design Engineer, Gerald Szykulski.

22. Gerald Szykulski has assigned to Plaintiff RSI all his rights, title and interest in the Szykulski Application and the two-piece rotary union technology as described and shown in the '202 Provisional Application, the '942 Application, the '040 Application and the '082 Patent.

23. Plaintiff RSI has requested that Defendant Hendrickson consent to the correction of inventorship as it relates to patent applications concerning the two-piece rotary union invented by Gerald Szykulski. Rather than consenting to the correction of inventorship, on September 15, 2005 Defendant Hendrickson canceled claims in the '942 Application and the '040 Application, which was then unpublished. Defendant Hendrickson subsequently allowed the '942 Application to go abandoned.

24. Plaintiff RSI's Design Engineer, Gerald Szykulski, also petitioned the Director of the United States Patent and Trademark Office ("USPTO") to correct inventorship on the '942 Application and the '040 Application. Gerald Szykulski's petitions to correct inventorship were denied by the USPTO for lack of consent to correction of inventorship by the assignee, Defendant Hendrickson.

25. Plaintiff RSI has suffered financial and reputational injury by Defendant Hendrickson's willful disregard in recognizing the inventive contributions in the two-piece rotary union for a tire inflation system and conscious decision not to consent to a correction of inventorship in the '202 Provisional Application, the '942 Application, the '040 Application and the '082 Patent.

26. In the most recent Office Action of the Szykulski Application, the Examiner applied the published patent application of the '942 Application as prior art and rejected all of the pending claims because Gerald Szykulski is not listed as an inventor on the '942 Application.

27. Upon information and belief, Defendant Hendrickson has been and is currently commercializing the two-piece rotary union technology assigned to Plaintiff RSI.

**COUNT I – DECLARATORY JUDGMENT**

28. Plaintiff RSI incorporates and repeats the foregoing paragraphs 1-27 of this Complaint.

29. A bona fide dispute exists between Plaintiff RSI and Defendant Hendrickson concerning the inventorship and ownership rights of the subject matter disclosed and claimed in the '082 Patent and the related patent applications – the '202 Provisional Application, the '942 Application, the '040 Application and the Szykulski Application.

30. Plaintiff RSI has a legal and equitable interest in the controversy as Plaintiff RSI's Design Engineer, Gerald Szykulski, conceived and developed and owns subject matter disclosed and claimed in the '082 Patent and the subject matter disclosed in the related patent applications – the '202 Provisional Application, the '942 Application, the '040 Application and the Szykulski Application, and has assigned all rights, title and interest in such subject matter to Plaintiff RSI.

31. As an assignee of the subject matter disclosed and claimed in the '082 Patent and the subject matter disclosed in the related patent applications – the '202 Provisional Application, the '942 Application, the '040 Application and the Szykulski Application, Plaintiff RSI has a legal and equitable interest in the controversy as an owner of the '082 Patent and the related patent applications – the '202 Provisional Application, the '942 Application, the '040 Application, and an equitable titleholder to the '082 Patent the related patent applications – the '202 Provisional Application, the '942 Application, and the '040 Application.

32. As the assignee of the subject matter disclosed and claimed in the '082 Patent and related patent applications – the '202 Provisional Application, the '942 Application and the '040

Application, Plaintiff RSI has a legal and equitable interest in the controversy to make a claim of priority in the Szykulski Application to at least the '202 Provisional Application and the '942 Application before the USPTO.

33. Defendant Hendrickson is commercializing the subject matter conceived and developed by Szykulski and assigned to Plaintiff RSI.

34. The issues concerning inventorship, ownership and commercialization of the subject matter conceived and developed by Plaintiff RSI's Design Engineer, Gerald Szykulski, and owned by Plaintiff RSI are ripe for adjudication.

35. The failure of Plaintiff RSI's Design Engineer, Gerald Szykulski, to be listed as an inventor of the subject matter disclosed and claimed in the '082 Patent and the related patent applications -- the '202 Provisional Application, the '942 Application and the '040 Application, is in error and occurred without deception or fraud by Plaintiff RSI or Gerald Szykulski.

36. The '082 Patent and the related patent applications -- the '202 Provisional Application, the '942 Application and the '040 Application, must be corrected pursuant to 35 U.S.C. §§ 116 and 256 to name Gerald Szykulski as an inventor.

37. Based upon the foregoing facts and pursuant to 28 U.S.C. §§ 2201 and 2202, and under 28 U.S.C. § 1338(a) and 35 U.S.C. §§ 116 and 256, Plaintiff RSI seeks a declaratory judgment from this Court that:

a) Gerald Szykulski is an inventor of the subject matter claimed and disclosed in the '082 Patent and the related patent applications -- the '202 Provisional Application, the '942 Application and the '040 Application;

b) Plaintiff RSI is a legal owner of the subject matter claimed and disclosed in the '082 Patent and the related patent applications – the '202 Provisional Application, the '942 Application and the '040 Application;

c) Plaintiff RSI is an equitable owner of the subject matter claimed and disclosed in the '082 Patent and the related patent applications – the '202 Provisional Application, the '942 Application and the '040 Application; and

d) Defendant Hendrickson shall consent to correction of inventorship and execute all necessary documents for correction of inventorship on the '082 Patent and the related patent applications – the '202 Provisional Application, the '942 Application and the '040 Application.

**JURY DEMAND**

38. Pursuant to FED. R. CIV. P. 38(b), Plaintiff RSI requests a trial by jury.

**PRAYER FOR RELIEF**

**WHEREFORE**, Plaintiff Szykulski prays for relief as follows:

1. A declaratory judgment that:

a) Gerald Szykulski is an inventor of the subject matter claimed and disclosed in the '082 Patent and the related patent applications – the '202 Provisional Application, the '942 Application and the '040 Application;

b) Plaintiff RSI is a legal owner of the subject matter claimed and disclosed in the '082 Patent and the related patent applications – the '202 Provisional Application, the '942 Application and the '040 Application;

c) Plaintiff is an equitable owner of the subject matter claimed and disclosed in the '082 Patent and the related patent applications – the '202 Provisional Application, the '942 Application and the '040 Application; and




d) Defendant Hendrickson shall consent to correction of inventorship and execute all necessary documents for correction of inventorship on the '082 Patent and the related patent applications – the '202 Provisional Application, the '942 Application and the '040 Application, before the United States Patent and Trademark Office.

2. Such other relief as the Court may deem just and equitable.

Respectfully submitted,

Dated: June 18, 2009

By: 

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